



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/584,062

06/22/2006

Tetsuyuki Nakayasu

2006_0976A

8967

52349

7590

01/07/2009

WENDEROTH, LIND & PONACK L.L.P.

2033 K. STREET, NW

SUITE 800

WASHINGTON, DC 20006

EXAMINER

BENGZON, GREG C

ART UNIT

PAPER NUMBER

2444

MAIL DATE

DELIVERY MODE

01/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/584,062	Applicant(s) NAKAYASU, TETSUYUKI	
	Examiner GREG BENZON	Art Unit 2444	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/22/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application has been examined. Claims 1-15 are pending.

Priority

This application claims benefits of priority from Foreign Application 2003-429445 filed December 25, 2003.

The effective date of the claims described in this application is December 25, 2003.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 06/22/2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta (US Publication 2005/0081159) further in view of McLaren (US Patent 6064794) further in view of what was well-known in the networking art.

Gupta disclosed (re. Claim 1) an electronic mail processing apparatus comprising: a data receiving section operable to receive mail data including video data or audio data; (Gupta-Paragraph 92, Paragraph 163, Paragraph 77-Paragraph 79) a cited data detecting section operable to detect a cited part of the received video data or audio data as cited data from the mail data received by the data receiving section; (Gupta-Paragraph 96-Paragraph 98) and a reproduction control section operable to control a reproducing method of the received mail data. (Gupta-Paragraph 92, Paragraph 163, Paragraph 77-Paragraph 79)

While Gupta substantially disclosed the claimed invention Gupta did not disclose (re. Claim 1) wherein the reproduction control section controls the reproduction method so that a reproduction method for the cited data is deferent from a reproduction method for data other than the cited data in the received mail data.

McLaren disclosed (re. Claim 1) wherein the reproduction control section controls the reproduction method so that a reproduction method for the cited data is different from a reproduction method for data other than the cited data in the received mail data. (McLaren-Column 5 Lines 40-65)

Gupta and McLaren are analogous art because they present concepts and practices regarding the playback control of video segments. At the time of the invention it would have been obvious to combine McLaren into Gupta. The motivation for said combination would have been to facilitate various trick-play modes by controlled selection of "replay" locations. (McLaren-Column 2 Lines 20-35)

Claim 8 (re. method) is rejected on the same basis as Claim 1.

Gupta-McLaren disclosed (re. Claim 2,9) wherein the reproduction control section controls the reproduction speed of the mail data so as to reproduce the data other than the cited data in the received mail data at a first speed, and reproduce the cited data at a second speed which is faster than the first speed. (McLaren-Column 5 Lines 40-65)

Gupta-McLaren disclosed (re. Claim 3,10) wherein the cited data includes information relating to a creator of the mail data in a specified region, (Gupta-Paragraph 52, Paragraph 61-63) and the cited data detecting section detects the cited portion by using the information relating to the creator. (Gupta-Paragraph 52, Paragraph

Art Unit: 2444

61-63)

Gupta-McLaren disclosed (re. Claim 4,11) wherein the video data or audio data included in the cited data is data compressed by a specified compressing method (McLaren-Column 5 Lines 40-65, Column 6 Lines 60-65) and having a header portion in which information relating to a creator of the mail data is recorded. (Gupta-Paragraph 52, Paragraph 61-63)

Gupta-McLaren disclosed (re. Claim 5,12) wherein the cited data includes information relating to a creator of the mail data in a form of a digital watermark embedded in the video data or audio data, and the cited data detecting section detects the cited data by using the information relating to the creator embedded in a form of a digital watermark.

The Examiner notes that at the time of the invention the use of digital watermarks with email and multimedia content was well-known in the networking art. It would have been obvious to use digital watermarks in the Gupta-McLaren in order to provide a unique identifier for said content and content creator.

Art Unit: 2444

Gupta-McLaren disclosed (re. Claim 6,13) comprising a data creating section operable to create the mail data for transmission including video data or audio data, wherein when creating the mail data, the data creating section stores information relating to a creator of the mail data in a specified recording region of the video data or audio data. (McLaren-Paragraph 61-Paragraph 63)

Gupta-McLaren disclosed (re. Claim 7,14) a data creating section operable to create the mail data for transmission including video data or audio data, wherein when creating the mail data, the data creating section embeds information relating to a creator of the mail data in a form of a digital watermark in the video data or audio data.

The Examiner notes that at the time of the invention the use of digital watermarks with email and multimedia content was well-known in the networking art. It would have been obvious to use digital watermarks in the Gupta-McLaren in order to provide a unique identifier for said content and content creator.

Gupta-McLaren disclosed (re. Claim 15) an electronic mail processing system comprising a first mail processing apparatus and a second mail processing apparatus

Art Unit: 2444

which exchanges electronic mails with the first mail processing apparatus, a) the first mail processing apparatus including: a data transmitting and receiving section operable to transmit and receive mail data including video data or audio data, (Gupta-Paragraph 92, Paragraph 163, Paragraph 77-Paragraph 79) a cited data detecting section operable to detect a cited part of video data or audio data as cited data from the received mail data, (Gupta-Paragraph 96-Paragraph 98) a reproduction control section operable to control a reproducing method of the received mail data (Gupta-Paragraph 92, Paragraph 163, Paragraph 77-Paragraph 79)

so that a reproduction method for the cited data is deferent from a reproduction method for data other than the cited data in the received mail data, (McLaren-Column 5 Lines 40-65)

and a data creating section operable to create mail data for transmission by adding information relating to a creator of the mail data to video data or audio data included in the mail data, (Gupta-Paragraph 52, Paragraph 61-63) and b) the second mail processing apparatus including: a data transmitting and receiving section operable to transmit and receive mail data, (Gupta-Paragraph 92, Paragraph 163, Paragraph 77-Paragraph 79)

and a data editing section operable to edit the mail data received in the data transmitting and receiving section, (Gupta-Paragraph 92, Paragraph 163, Paragraph 77-Paragraph 79)

wherein the second mail processing apparatus creates a reply mail (Gupta-Figure 19, Paragraph 127) including as cited data a part or whole of video data and

Art Unit: 2444

audio data included in the received mail data, by the data editing section, and transmits a reply mail to a sender of the received mail data through the data transmitting and receiving section. (Gupta-Figure 19, Paragraph 127)

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to the enclosed PTO-892 form.

Art Unit: 2444

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREG BENGZON whose telephone number is (571)272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg Bengzon/
Examiner, Art Unit 2444